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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Mitch Fredrick Singer

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27189

7590

05/07/2009

PROCOPIO, CORY, HARGREAVES & SAVITCH LLP

530 B STREET

SUITE 2100

SAN DIEGO, CA 92101

EXAMINER

LANIER, BENJAMIN E

ART UNIT

PAPER NUMBER

2432

NOTIFICATION DATE

DELIVERY MODE

05/07/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@procopio.com

PTONotifications@procopio.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/686,686	<b>Applicant(s)</b> SINGER ET AL.	
	<b>Examiner</b> BENJAMIN E. LANIER	<b>Art Unit</b> 2432	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27, 30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27, 30, 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/18/2008</u>  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04 March 2009 has been entered.

### ***Response to Amendment***

2. Applicant's amendment filed 04 March 2009 amends claims 1, 15, and 30-31. Applicant's amendment has been fully considered and entered.

### ***Response to Arguments***

3. Applicant argues paragraph [0031]-[0033] provide support for the amended claim language, however, the cited paragraphs do not specify that copies of said sub-copy content data can be made "only by other clients".

4. Applicant argues, "Novak's license information merely allows the client to access specific content that was previously received and stored...without any specific mention of how to allow access to those specific content." In response, Examiner would initially like to point out that the claims do not require "any specific mention of how to allow access," and the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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5. Applicant argues, “Novak do not specifically recite ‘sub-copy licenses’ or ‘sublicenses’.”

This argument is not persuasive because Novak discloses utilizes sub-portions of the licenses ([0107] & [0119]), which would meet the limitation of “sublicenses” or “sub-copy licenses”.

6. Applicant argues, “it cannot be maintained that these ‘sublicenses’ refer to ‘sub-copy licenses’ which are updated according to the received license data and correspond to sub-copy versions stored on the client.” This argument is not persuasive because Novak discloses that the license information can include sublicenses and is required to be re-verified after expiration ([0107 & 0119]), which would meet the limitation of updating a sub-copy version stored on the client because when the sublicense is re-verified a new expiration date would be added to the sublicense which would be sufficient to meet the claimed updated.

7. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-27, 30-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed

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invention. The specification does not support the amendment that specifies “copies of said sub-copy locked content data can be made only by other clients connected to said hub network.”

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, 3-5, 7-15, 17-27, 30-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Novak, U.S. Publication No. 2003/0097655. Referring to claims 1, 8, 15, Novak discloses a client sending a license request to a server (Figure 4, 409), which meets the limitation of sending a license request from a client to a server, sending a connection confirmation from said client to said server, said connection confirmation indicates said client is connected to said server, sending a connection confirmation request from said server to said client, said connection confirmation request requests confirmation that said client is connected to said server.

Subsequent to the request, the client receives the license (Figure 4, 411) and stores the license in memory (Figure 4, 306), which meets the limitation of receiving license data at said client from said server. The licenses are also maintained by the source ([0120]), which meets the limitation of a copy of a source version stored on said server, the source version being a source for copies of content data in the hub network. The client and the server are connected over a hub network (Figure 1, 101). The license information allows the client to access specific content that was previously received and stored ([0099]), which meets the limitation of said license request

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identifies a sub-copy version stored on said client, said sub-copy version includes sub-copy locked content data, and said license data is bound to said hub network. The limitation “copies of said sub-copy locked content data can be made only by other clients connected to said hub network” has not been given patentable weight because the limitations represents language that suggests or makes optional while not requiring steps to be performed and does not limit the claim to a particular structure (MPEP 2111.04).

Referring to claims 3, 17, Novak discloses that the license information can include sublicenses and is required to be re-verified after expiration ([0107 & 0119]), which meets the limitation of updating a sub-copy license for a sub-copy version stored on said client, wherein said sub-copy license corresponds to said sub-copy version, and updating license data for said sub-copy version includes updating said sub-copy license according to said received license data, said license data corresponds to a sub-copy license for said sub-copy version and includes data for updating said sub-copy license.

Referring to claims 4, 18, Novak discloses that the license information can include sublicenses for content ([0119]), which meets the limitation of said license data is a sub-copy license indicating permissions for using said sub-copy version.

Referring to claims 5, 19, Novak discloses that the sublicenses have set periods of validity ([0040] & [0108]), which meets the limitation of said sub-copy license indicates an expiration period, and said expiration period indicates an amount of time for which said sub-copy license is valid, when said expiration time has been reached after sending said license data, said sub-copy license expires and becomes disabled.

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Referring to claims 7, 20, Novak discloses that the license request includes an identification of specific content ([0024]), which meets the limitation of said license request indicates said sub-copy version.

Referring to claims 9, 22, Novak discloses that the client and server are connected within a local environment ([0052]), which meets the limitation of said connection confirmation indicates said client is within a local environment of said server, and said local environment is a limited area defined relative to said server.

Referring to claims 10-12, 23-26, Novak discloses that once a license has expired on the client, a connection with the server is re-established to receive a new license and license key used to access the content ([0106]-[0107]), which meets the limitation of sending a security confirmation from said client to said server, wherein said security confirmation indicates a state of security data stored on said client, receiving a security confirmation at said server from said client, wherein said security confirmation indicates said state of said security data stored on said client, receiving a security update at said client from said server, wherein said security update includes new security data, said security data includes a new key for decryption.

Referring to claim 13, Novak discloses that a licensing term is defined that is longer than validity period of the individual licenses ([0106]). Therefore, subsequent licenses would have a validity term based off of the time remaining in the licensing term, which meets the limitation of setting an expiration time according to said received license data.

Referring to claim 14, Novak discloses that the content is provided to the network from content providers through high-power satellites in geosynchronous orbit ([0054]-[0055]), which

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meets the limitation of receiving said sub-copy version from a device that is a member of a different hub network from said hub network.

Referring to claim 27, Novak discloses that the server stores a revocation list that is used to check whether a license has been revoked ([0027]), which meets the limitation of checking a revocation list to determine whether said client is included in said revocation list, wherein said revocation list is stored on said server.

Referring to claims 30-31, Novak discloses a client sending a license request to a server (Figure 4, 409). Novak discloses that once a license has expired on the client, a connection with the server is re-established to receive a new license and license key used to access the content ([0106]-[0107]), which meets the limitation of sending/receiving a refresh request from a client to/at a server, sending a connection confirmation from said client to said server. Subsequent to the request, the client receives the license (Figure 4, 411) and stores the license in memory (Figure 4, 306), which meets the limitation of sending/receiving updated license data at said client from said server. Novak discloses that the license information can include sublicenses and is required to be re-verified after expiration ([0107 & 0119]), which meets the limitation of updating a sub-copy license stored on said client according to said updated license data. The client and the server are connected over a hub network (Figure 1, 101). The license information allows the client to access specific content that was previously received and stored ([0099]), which meets the limitation of said refresh request identifies a sub-copy version stored on said client, said sub-copy version includes sub-copy locked content data, said sub-copy version corresponds to said sub-copy version, and said sub-copy license is bound to said hub network. The limitation “copies of said sub-copy locked content data can be made only by other clients



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connected to said hub network” has not been given patentable weight because the limitations represents language that suggests or makes optional while not requiring steps to be performed and does not limit the claim to a particular structure (MPEP 2111.04).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 2, 6, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novak, U.S. Publication No. 2003/0097655, in view of Molaro, U.S. Publication No. 2004/0139027. Referring to claims 2, 16, Novak does not disclose synchronizing the client and server utilizing secure clocks. Molaro discloses synchronizing the client and server utilizing secure clocks ([0010]), which meets the limitation of synchronizing a client clock with a server clock by setting said client clock according to said server clock before receiving license data including a sub-copy license at said client, wherein said client clock is a secure clock of said client, said server clock is a secure clock of said server. It would have been obvious to one of ordinary skill

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in the art at the time the invention was made for the client and server in Novak to be synchronized with secure clocks in order to ensure proper decryption of the content as taught by Molaro ([0009]).

Referring to claim 6, Novak discloses that the sublicenses have set periods of validity ([0040] & [0108]), which meets the limitation of setting an expiration time according to said expiration period including resetting said expiration time if said expiration time was previously set to a different value, said client will not decrypt said sub-copy locked content data when said sub-copy license is disabled. The licenses include encryption keys to access the content ([0105]). Novak does not disclose synchronizing the client and server utilizing secure clocks. Molaro discloses synchronizing the client and server utilizing secure clocks ([0010]), which meets the limitation of wherein said client has a secure client clock, when said client clock indicates that the current expiration time has been reached, said sub-copy license expires and becomes disabled. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the client and server in Novak to be synchronized with secure clocks in order to ensure proper decryption of the content as taught by Molaro ([0009]).

### ***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN E. LANIER whose telephone number is (571)272-3805. The examiner can normally be reached on M-Th 7:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin E Lanier/  
Primary Examiner, Art Unit 2432